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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,352	07/07/2003	Peter M. Bonutti	782-A03-003-1	7916

33771 7590 01/25/2007  
PAUL D. BIANCO: FLEIT, KAIN, GIBBONS,  
GUTMAN, BONGINI, & BIANCO P.L.  
21355 EAST DIXIE HIGHWAY  
SUITE 115  
MIAMI, FL 33180

EXAMINER
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YABUT, DIANE D

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/614,352

Applicant(s)

BONUTTI, PETER M.

Examiner

Diane Yabut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,8-21,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-21,24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This action is in response to applicant's amendment received on 1 November 2006.

Examiner acknowledges the clarification made to the Drawings, and therefore the objection has been withdrawn. The examiner also acknowledges the amendment made to Claim 9.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bartlett** (U.S. Patent No. **5,540,718**) in view of **Ogiu et al.** (U.S. Patent No. **4,235,238**).

Claims 1-3 and 8-11:      **Bartlett** discloses a device for securing a suture having a cylindrical body portion defining a longitudinal central axis including a first end and a second end, wherein the second end is pointed and conical in shape and being capable of forming an opening in the body tissue in the patient's body when a force is applied against a trailing end of the cylindrical body in a direction extending along the longitudinal central axis of the cylindrical body, and the pointed end having a central axis which is coincident with the longitudinal central axis of the cylindrical body and a

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plurality of openings each defining a passage through the body portion orthogonal, or transverse to the longitudinal central axis (the openings being parallel to one another) which allows for threading of a suture (Figure 1A and col. 5, lines 34-37). Bartlett discloses the claimed device except for one of the passages being formed partially in the body portion and partially in the pointed end portion.

Ogiu et al. teaches a tissue-suturing apparatus with a passage used for threading suture that is formed partially in the body portion 1 and partially in the pointed end portion 3 (Figure 51). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the Bartlett reference by having one of the passages being formed partially in the body portion and partially in the pointed end portion, since Applicant has not disclosed that having the passage being formed partially in the body portion and partially in the pointed end portion solves any stated problem or is for any particular purpose and it appears that the device of Bartlett would perform equally well with a passage formed partially in the body portion and partially at its pointed end portion.

3. Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bartlett** (U.S. Patent No. 5,540,718) and **Ogiu et al.** (U.S. Patent No. 4,235,238).

Claims 12-21: Bartlett and Ogiu et al. discloses the claimed device except for the cylindrical body being made of allogenic, autogenic, xenogenic, cortical bone, or a single piece of freeze dried bone, or made of a material selected from the group consisting of a metal, metal alloy, biodegradable material and bioerodible material,

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wherein the suture is secured relative to a body tissue being soft tissue or bone. It would have been obvious to one of ordinary skill in the art to use any of the above materials in either soft tissue or bone with the combined device of Bartlett and Ogiu, since it was known in the art that these materials are used with suture devices with soft tissue or bone.

4. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being obvious over **Bartlett** (U.S. Patent No. **5,540,718**) and **Ogiu et al.** (U.S. Patent No. **4,235,238**), as applied to Claim 9 above, and further in view of **Bonutti et al.** (U.S. Patent No. **6,368,343**).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing

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that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Claims 24 and 25: Bartlett and Ogiu et al. disclose the claimed device, including a suture **64** connected to a device under tension and extending through the first and second passages, which is understood as the first and second passages not being separate passages, in order to be properly, fixedly threaded to the suture anchor (Bartlett: Figure 8, col. 6, lines 47-55), except for a retainer connected to the suture for maintaining the tension in the suture and made of a material that becomes flowable when ultrasonic vibratory energy is applied.

Bonutti et al. teaches a retainer connected to a suture for maintaining the tension in the suture and made of a material that becomes flowable when ultrasonic vibratory energy is applied so that when subject to pressure, there is insignificant deformation of the suture (col. 7, lines 8-17). It would have been obvious to one of ordinary skill to provide a retainer that becomes flowable when ultrasonic vibratory energy is applied, as taught by Bonutti et al., to Bartlett and Ogiu et al. since it was known in the art that retainers maintain tension in sutures and that retainers made of flowable material is beneficial in preventing deformation of the suture.

### ***Response to Arguments***

5. Applicant's arguments filed 1 November 2006 have been fully considered but they are not persuasive.

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Applicant's arguments with respect to the Adams reference for Claims 9-11, 12-21. 22-23 are moot in view of the new rejections above, as necessitated by Applicant's amendment.

Applicant argues that Ogiu et al. fails to disclose a suture retaining device having a pointed end portion with a passage therethrough. The examiner disagrees. As maintained in paragraph 2, Ogiu teaches a device that retains sutures having a pointed end portion and a body portion with a passage used for threading suture that is formed partially in the body portion and partially in the pointed end portion.

Applicant argues that the present application claims priority to Bonutti – however it is Bonutti *et al.* which is a different inventive entity and may be used as prior art.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER